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REMARKS

Claims 1-24 are currently pending in the subject application and are presently under consideration. Favorable consideration of the subject application is respectfully requested in view of the following comments herein.

I.   Rejection of Claims 1-24 Under 35 U.S.C. §102(b)

Claims 1-24 stand rejected under 35 U.S.C. §102(b) as being unpatentable over Template Software Corporation's SNAP 8.0. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Template Software Corporation's SNAP 8.0 does not teach each and every element of the subject invention as recited in the subject claims.

> A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject invention discloses systems and methods for configuring software components. Specifically, independent claim 1 (and similarly independent claims 9, 13, 17, 22, 23, 24) recites a configurable module comprising one of more configurable and non-configurable data elements. Transformation instructions facilitate configuring the one or more configurable data elements. The one or more non-configurable data elements are utilized to describe the one or more configurable data elements. Template Software Corporation's SNAP 8.0 ("SNAP") does not teach or suggest such claimed elements of the subject invention.

More particularly, SNAP does not disclose non-configurable data elements that *describe one or more configurable data elements*. The Examiner cites SNAP, page 3-62 "Constants Tab" to teach this limitation. However, this page is not directed to non-configurable data elements that describe one or more configurable data elements, as recited in the subject claims. Rather, the "Constants Tab" includes the constant name, access levels and value of each

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constant. A constant is defined by Merriam Webster Dictionary as "something invariable or unchanging: as a *number that has a fixed value* in a given situation or universally or that is characteristic of some substance or instrument." Thus, *constant values are non-configurable by definition* and cannot be configured or changed by non-configurable elements, as recited in the subject claims.

Moreover, SNAP does not disclose *transformation instructions employed to configure* the one or more configurable data elements. The Examiner cites page 3-44, "Functions Tab" to teach such *transformation instructions*. However, the "Functions Tab" as described in SNAP is concerned with function information, function parameters and local attributes. The Functions Tab permits the user to view all the functions in a class, but *does not allow the user to configure* any of the data elements as required by the subject invention. In addition, the functions are *not transformation instructions* as disclosed in the subject application. Instead, the getters and setters listed are used merely to identify and retrieve values, *not to configure configurable data elements* as recited in the subject claims. For example, as disclosed in the Function Tab, a function "GetByRmtSchema" is employed to retrieve an object graph from a remote SIB. Thus, such a function is not concerned with *configuring configurable data elements*, as recited in the subject claims.

The Examiner relies on an incorrect interpretation of transformation instructions to read, *via inherency*, such instructions into SNAP. Specifically, the Examiner states that functions and getters and setters are inherent in Object Oriented programming and thus transformation instructions are *inherently* employed to configure configurable data elements. (Office Action, p. 4). However, as noted above, getters and setter are not the equivalent of transformation instructions and, therefore, the *inherency* conclusion drawn by the Examiner is erroneous. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). The fact that a characteristic may be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was [not] based on ... what was necessarily present in the prior art). Since SNAP does not disclose transformation instructions, as recited in the subject claims, but instead discloses

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functions, the missing descriptive is *not* necessarily present and would not be recognized by persons of ordinary skill. Thus, contrary to the Examiner's contention, SNAP does not disclose, expressly or inherently, transformation instructions, as recited in the subject claims.

In addition, SNAP does not teach or suggest a *method* for importing a configurable data set into a target data set *via* obtaining one or more data elements and transformation instructions from a configurable module and applying such instructions to a copy of one or more data elements from the configurable module to configure the one or more data elements. The Examiner cites the argument "as per the rejection for claim 1." However, there is *no method taught in SNAP* that relates to importing a data set, obtaining data elements and transformation instructions and applying such instructions to configure the one or more data elements, as required in the subject claims.

In view of at least the foregoing, it is respectfully submitted that SNAP neither anticipates nor suggests applicants' invention as recited in independent claims 1, 9, 13, 17, 22, 23 and 24 (and claims 2-8, 10-12, 14-16 and 18-21 which respectively depend therefrom), and this rejection should be withdrawn.

II.   Rejection of Claim 23 Under 35 U.S.C. §102(b)

Claim 23 is rejected under 35 U.S.C. §102(b) based upon a public use or sale of the invention. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Template Software Corporation's SNAP 8.0 ("SNAP") does not teach each and every element of the subject invention as recited in the subject claims.

As noted above, SNAP does not teach or suggest a configurable module having one or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available and one or more transformation instructions that facilitate configuring the one or more configurable data elements. Thus, it is of no consequence when SNAP was released since SNAP does not teach or suggest the subject invention as recited in the subject claims. Accordingly, this rejection should be withdrawn.

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III.   Conclusion

The present application is believed to be in condition for allowance, in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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